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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,994	12/03/2003	Kedar R. Belhe	47563.0015	4512
57600	7590	04/17/2009		
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EXAMINER				
WOO, JULLAN W				
ART UNIT		PAPER NUMBER		
3773				
MAIL DATE		DELIVERY MODE		
04/17/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/726,994

Applicant(s)

BELHE ET AL.

Examiner

Julian W. Woo

Art Unit

3773

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 21, 22 and 24-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 21, 22 and 24-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 3, 2009 has been entered.

Claim Objections

2. Claim 1 is objected to because of an error that should be corrected as follows: In line 10, after the second occurrence of "the," insert --second--, per Applicant's remarks regarding the rejection of claims 1-6 under 35 U.S.C. 112, 2nd paragraph.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3-7, 11-18, 21, 22, and 24-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Modesitt et al. (6,136,010). Modesitt et al. disclose, at least in figures 4-5, 11A-11E, and 13 and in col. 10, line 18 to col. 11, line 29; a vascular closure device and a method with the device for closing a vascular opening; where the device

includes first and second needles (38, 38'), a suture (34), a snare (40, see fig. 4) configured to grasp suture), the snare comprising a loop portion (tubular collar 50, see col. 7, lines 40-43) and being configured to move with the second needle from a retracted position to an extended position; a pre-tied knot (80), a handle (20), and an anchor (24) configured to extend through an opening in a blood vessel, the anchor being configured to move between a contracted configuration where the anchor is sized to fit through the opening in the blood vessel and an expanded configuration where the anchor is too large to fit through the opening in the blood vessel; where the first and second needles extend outward and away from a sheath (12) at an angle of 3 deg. to 20 deg.; where a needle (38 or 38') is positioned at a distal end of the device, where a suture (34) is configured to move with the needle from a retracted position to an extended position, where a portion of the suture extends lengthwise from a tip of the needle toward a proximal end of the device and outside of the needle (see fig. 11A) where the method includes inserting a sheath or sleeve (12) into a vessel, inserting a snare (40 and/or 42) and a needle (38) on a first side of a vessel opening, inserting a suture (34) and another needle (38') on a second side of the opening, grasping the suture with the snare, pulling the suture across the vessel opening (see fig. 11d), directing the distal end of the suture and a needle (38) through a pre-tied knot (80) at a proximal end of the suture, cinching the knot or tightening the suture, disengaging and withdrawing the sheath (12) from the vessel opening; where the device is secured in the blood vessel (via 24), where the sheath is anchored in the vessel with a pair of

extendable feet (24a and 24b or 22 and 24), and where a safety wire (GW) can be inserted into the vessel opening and be used to facilitate reinsertion of the sheath.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riza (5,562,688) in view of Goldrath (5,330,488), and further in view of Kammerer (5,562,684). Riza discloses the invention substantially as claimed. Riza discloses, at least in figure 5, a device including a needle (82) movable between retracted and extended positions with respect to a tubular housing (11), a suture (81), and a snare (84) configured to move with the needle, where the snare comprises a loop portion or wire loop (84) having a memory as claimed. However, Riza does not disclose another

needle configured to be movable between retracted and extended positions with respect to the tubular housing (11) and a suture movable with another needle between retracted and extended positions, where the suture proximal end includes a pre-tied knot, where the suture and needle may be directed through the pre-tied knot. Nevertheless, Riza discloses, in col. 8, lines 25-28, that elongated tools may be inserted into the tubular housing for manipulation of suture. Goldrath teaches, at least in figures 2 and 6, an elongated tool or needle (40) for manipulation of suture. It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Goldrath, to apply a needle for carrying and manipulation of a suture in the Riza's device. Such a needle would allow the guidance of suture into relatively inaccessible or closed surgical sites, where a suturing procedure can further be more performed with the use of a snare as disclosed by Riza (and as also taught by Goldrath). Moreover, Kammerer teaches, at least in figures 16-25 a suture (100) with a pre-tied knot (102) on its proximal end. It also would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Kammerer, to include a pre-tied knot with the suture of Riza's device. Such a knot would allow a quick and convenient means for tying and tightening a suture around tissues to be joined together after the suture and a needle are directed through the pre-tied knot.

7. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans et al. (5,728,114). Evans et al. disclose the invention substantially as claimed. Evans et al. disclose, at least in figures 7-12 and in col. 7, line 28 to col. 8, line 20; a vascular closure device including an anchor (22) configured to extend through an

opening in a blood vessel, the anchor being configured to move between a contracted configuration (see fig. 10), where the anchor is sized to fit through the opening in the blood vessel and expanded configuration (see fig. 11) where the anchor is too large to fit through the opening in the blood vessel, a snare (42) configured to be inserted through a wall of the blood vessel at a location that is adjacent to the opening in the blood vessel (within the blood vessel) and comprising a loop portion; a suture (24) configured to be inserted through the wall at another location adjacent the opening, the snare also being configured to grasp the suture in the blood vessel and retract the suture through the wall of the blood vessel, where the device is configured to close the opening in the blood vessel (see figs. 9-11), where the snare comprises a wire loop (42) having a memory that causes the loop to open in a repeatable orientation (i.e., the loop is flexible), where the snare and the suture each move between a retracted position and an extended position to allow the snare and the suture to be inserted through the wall of the blood vessel (from within the blood vessel), and where the device further comprises a handle set (26 and 28) to allow an operator to control movement of the snare and the suture.

However, Evans et al. do not specifically disclose (in figures 7-12) that the vascular closure device includes a suture and needle combination. Nevertheless, Evans et al. teach, at least in figures 26-31 and col. 13, lines 30-64; a suture (208) and needle (206) combination. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a needle with suture 24. Such a modification would allow the suture to be manipulated for closing the opening in the

blood vessel, where a needle would be used for tissue penetration and grasping (e.g., with forceps).

8. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens (5,722,981) in view of Kammerer (5,562,684), and further in view of Burbank et al. (6,648,286). Stevens discloses the invention substantially as claimed. Stevens discloses, at least in figures 7(a)-7(c); a vascular closure device, where the device includes first and second needles (112, 113) configured to move between retracted and extended positions, a suture (121) configured to move with the first needle, and a snare (119) configured to move with the second needle, the snare including a wire loop having a memory; where the wire loop opens adjacent to the first needle to grasp the suture and is configured so that the suture is positionable inside the wire loop of the snare. However, Stevens does not disclose a pre-tied knot disposed on a proximal end of the suture such that a distal end of the suture can be directed through the pre-tied knot. Kammerer teaches, at least in figures 16-25, a suture (100) with a pre-tied knot (102) on its proximal end. It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Kammerer, to include a pre-tied knot with the suture of Stevens's device. Such a knot would allow a quick and convenient means for tying and tightening a suture around tissues to be joined together.

However, Stevens in view of Kammerer does not disclose that the first needle is positionable in the wire. Burbank et al. teach, at least in fig. 7-13 and col. 7, lines 38-52; a needle-like element (136) that is positionable in a wire loop (124) configured to accommodate the needle-like element. It would have been obvious to one having

ordinary skill in the art at the time the invention was made, in view of Burbank et al., to configure the wire loop of Stevens in view of Kammerer, so that the first needle is positionable in the wire loop of the snare. Such a modification would allow that the wire loop to be disposed at or on the distal end of the first needle and assuredly capture the suture moved through and out of the needle.

9. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sierra et al. (5,496,332) in view of Kammerer (5,562,684). Sierra et al. disclose the invention substantially as claimed. Sierra et al. disclose, at least in figures 2-6, a method of closing a vascular opening utilizing a vascular closure device, where the method includes inserting a sheath (12) into a vessel through a vessel opening, inserting a snare (34) into the vessel at a first location adjacent to the vessel opening (i.e., the perimeter of the opening), the snare including a wire loop; inserting a suture (66 or 68) with a needle (46 or 48) into the vessel at a second location adjacent to the vessel opening and into the wire loop, extending the wire loop across the vessel opening to grasp the suture; and pulling the suture across the vessel opening the through the vessel on the first side of the vessel opening. However, Sierra et al. do not disclose directing the distal end of the suture through a pre-tied knot formed on a proximal end of the suture to create a knot to approximate tissue. Kammerer teaches, at least in figures 16-25, a suture (100) with a pre-tied knot (102) on its proximal end. It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Kammerer, to include a pre-tied knot with the suture of Sierra et al. and to direct the distal end of the suture through the pre-tied knot. Such a knot and method

step would allow a quick and convenient means for tying and tightening a suture around tissues to be joined together.

Response to Amendment

10. The rejection under 35 U.S.C. 112, second paragraph is hereby withdrawn, but a claim objection is raised, since the correction described in the Remarks was not made in the claims.

With respect to arguments regarding the rejection based on Modesitt: Modesitt indeed discloses a "snare comprising a loop portion." That is, the ENCARTA World English Dictionary defines "loop" to include a "circular or oval fastener or handle: something that has a closed circular or oval shape and is often used to carry or fasten something," while the thesaurus within the same dictionary states that "loop" is synonymous with "ring" or "hoop." Accordingly, Modesitt's element 40 comprises a circular or oval fastener used to carry or fasten suture, and it includes at least loop portion 50, which can also be described as a ring or hoop portion of the tubular element.

With respect to arguments regarding the rejection based on Riza, Goldrath, and Kammerer: Applicant is first reminded that a recitation that an element is "configured to" perform a function is not a positive limitation but only requires the ability to so perform. *In re Hutchison*, 69 USPQ 138. As pointed out by the Applicant and in Riza, Goldrath, and Kammerer, one or both of the suture and snare and needles are movable relative to each other and/or relative to tissue. Thus, the suture, snare, and needles are "configured to move," i.e., capable of moving between the positions as claimed. The sequence of movement of the elements, as shown by Riza, Goldrath, and Kammerer, is

not germane to the argument put forth by the Applicant, since again, the claims only require that the elements have the ability to perform the claimed functions.

Similarly, with respect to arguments regarding the rejection based on Evans: The claims require that an element is "configured to" perform a function, e.g., "an anchor configured to extend through an opening in a blood vessel." As pointed out by the Applicant, Evans discloses a closure device with demonstrated application at a tissue opening. Thus, Evans's closure device is configured to be applied in an opening in a blood vessel. Applicant is further reminded that a recitation with respect to the manner in which a claimed apparatus is intended to be employed (e.g., "vascular" use) does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Evans substantially discloses the claimed structural limitations of the claimed apparatus.

Applicant's arguments with respect to claim 30 have been considered but are moot in view of the new ground(s) of rejection.

Finally, with respect to arguments regarding the rejection based on Sierra et al. and Kammerer: Sierra indeed discloses inserting a snare feature or suture feature into a vessel at locations adjacent to a vessel opening or adjacent to the opening and within the vessel lumen. The ENCARTA World English Dictionary defines "adjacent" to include "neighboring: situated near or close to something or each other, especially without touching." Thus, given the broadest reasonable interpretation of "adjacent," a snare feature or suture feature can be inserted into a vessel and be located adjacent to, i.e. near or close to a vessel opening as claimed. In short, the locations of the features

can be in the vicinity of the vessel opening, but not all of the features are required to be in the vessel wall.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian W. Woo whose telephone number is (571) 272-4707. The examiner can normally be reached Mon.-Fri., 7:00 AM to 3:00 PM Eastern Time, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Julian W. Woo/
Primary Examiner, Art Unit 3773